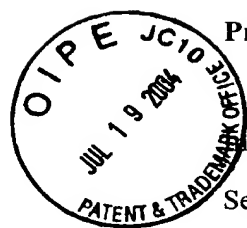


1755  
Blw



Practitioner's Docket

U 013615-2

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re application of Masahiro YATAKE

Serial No.: 09/914,482

Group No.: 1755

Filed: August 28, 2001

Examiner: Veronica F. Faison

For: INK COMPOSITION FOR INK-JET RECORDING AND INK SET  
COMPRISING THE SAME

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL

**WARNING:** Failure to file a complete response in compliance with § 1.135(c) leads to a reduction in patent term adjustment - See § 1.704(c)(7).

1. Transmitted herewith is an amendment for this application.

STATUS

2. The application is qualified as  
☐ a small entity.  
☒ other than a small entity.

CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10\*

(When using Express Mail, the Express Mail label number is **mandatory**;  
Express Mail certification is optional.)

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37 C.F.R. 1.8(a)

37 C.F.R. 1.10\*

- ☒ with sufficient postage as first class mail.

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Mailing Label No. \_\_\_\_\_ (mandatory)

TRANSMISSION

- ☐ transmitted by facsimile to the Patent and Trademark Office. to (708) 872-9306

Date: July 16, 2004

Signature

CLIFFORD J. MASS

(type or print name of person certifying)

Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

## EXTENSION OF TERM

**NOTE:** "Extension of Time in Patent Cases (Supplement Amendments) — If a timely and complete response has been filed after a Non-Final Office Action, an extension of time is not required to permit filing and/or entry of an additional amendment after expiration of the shortened statutory period.

*If a timely response has been filed after a Final Office Action, an extension of time is required to permit filing and/or entry of a Notice of Appeal or filing and/or entry of an additional amendment after expiration of the shortened statutory period unless the timely-filed response placed the application in condition for allowance. Of course, if a Notice of Appeal has been filed within the shortened statutory period, the period has ceased to run." Notice of December 10, 1985 (1061 O.G. 34-35).*

**NOTE:** See 37 C.F.R. §1.645 for extensions of time in interference proceedings, and 37 C.F.R. § 1.550(c) for extensions of time in reexamination proceedings.

**NOTE:** 37 C.F.R. § 1.704(b)". . . an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph."

3. The proceedings herein are for a patent application and the provisions of 37 C.F.R. 1.136 apply.

*(complete (a) or (b), as applicable)*

- (a) ☐ Applicant petitions for an extension of time under 37 C.F.R. 1.136 (fees: 37 C.F.R. 1.17(a)(1)-(4)) for the total number of months checked below:

|                          | <u>Extension<br/>(months)</u> | <u>Fee for other than<br/>small entity</u> | <u>Fee for<br/>small entity</u> |
|--------------------------|-------------------------------|--|---------------------------------|
| <input type="checkbox"/> | one month                     | \$ 110.00                                  | \$ 55.00                        |
| <input type="checkbox"/> | two months                    | \$ 420.00                                  | \$ 210.00                       |
| <input type="checkbox"/> | three months                  | \$ 950.00                                  | \$ 475.00                       |
| <input type="checkbox"/> | four months                   | \$ 1,480.00                                | \$ 740.00                       |
| <input type="checkbox"/> | five months                   | \$ 2,010.00                                | \$ 1,005.00                     |

Fee: \$ \_\_\_\_\_

If an additional extension of time is required, please consider this a petition therefor.

*(check and complete the next item, if applicable)*

- ☐ An extension for \_\_\_\_\_ months has already been secured. The fee paid therefor of \$ \_\_\_\_\_ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ \_\_\_\_\_

**OR**

- (b) ☒ Applicant believes that no extension of term is required. However, this is a conditional petition being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

## FEE FOR CLAIMS

4. The fee for claims (37 C.F.R. 1.116(b)-(d)) has been calculated as shown below:

|  |   | (Col. 1)                                  | (Col. 2)                              | (Col. 3)         | SMALL<br>ENTITY     |               | OTHER THAN A<br>SMALL ENTITY |                     |               |
|--|---|---|---------------------------------------|------------------|---------------------|---------------|------------------------------|---------------------|---------------|
|  |   | Claims<br>Remaining<br>After<br>Amendment | Highest No.<br>Previously<br>Paid For | Present<br>Extra | Rate                | Addit.<br>Fee | OR                           | Rate                | Addit.<br>Fee |
| Total  | * | Minus                                     | **                                    | =                | x \$ 9=             | \$            |                              | x \$ 18=            | \$            |
| Indep.   | * | Minus                                     | ***                                   | =                | x \$ 43=            | \$            |                              | x \$ 86=            | \$            |
| <input type="checkbox"/> First Presentation of Multiple Dependent Claims |   |   |                                       |                  | + \$145=            | \$            |                              | + \$290=            | \$            |
|  |   |   |                                       |                  | Total<br>Addit. Fee | \$ _____      | OR                           | Total<br>Addit. Fee | \$ _____      |

- \* If the entry in Col. 1 is less than the entry in Col. 2, write "O" in Col. 3,  
 \*\* If the "Highest No. Previously Paid For" IN THIS SPACE is less than 20, enter "20".  
 \*\*\* If the "Highest No. Previously Paid For" IN THIS SPACE is less than 3, enter "3".  
 The "Highest No. Previously Paid For" (Total or Indep.) is the highest number found in the appropriate box in Col. 1 of a prior amendment or the number of claims originally filed.

**WARNING:** "After final rejection or action (§ 1.113) amendments may be made canceling claims or complying with any requirement of form which has been made." 37 C.F.R. 1.116(a) (emphasis added).

(complete (c) or (d), as applicable)

- (c) ☒ No additional fee for claims is required.

OR

- (d) ☐ Total additional fee for claims required \$ \_\_\_\_\_

## FEE PAYMENT

5. ☐ Attached is a check in the sum of \$ \_\_\_\_\_  
☐ Charge Account No. 12-0425 the sum of \$ \_\_\_\_\_  
 A duplicate of this transmittal is attached.

## FEE DEFICIENCY

**NOTE:** *If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, (1065 O.G. 31-33).*

6. ☒ If any additional extension and/or fee is required, charge Account No. 12-0425.

### AND/OR

- ☒ If any additional fee for claims is required, charge Account No. 12-0425

Reg. No. 30,086

Tel. No. 212-708-1890

Customer No. 00140

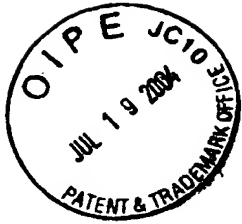
SIGNATURE OF PRACTITIONER

CLIFFORD J. MASS

(type or print name of practitioner)

P.O. Address

c/o Ladas & Parry LLP  
26 West 61 Street  
New York, N.Y. 10023



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Masahiro YATAKE  
Application No.: 09/914,482 Group No.: 1755  
Filed: August 28, 2001 Examiner: Veronica F. Faison  
For: INK COMPOSITION FOR INK-JET RECORDING AND INK SET COMPRISING  
THE SAME

Attorney Docket No.: U 013615-2

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

SECOND SUPPLEMENTAL RESPONSE

Further to Applicant's Amendment dated June 1, 2004 and Supplemental  
Response dated June 22, 2004, and in supplemental response to the Official Action of

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**CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10\***  
(When using Express Mail, the Express Mail label number is **mandatory**;  
Express Mail certification is optional.)

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**37 C.F.R. 1.8(a)**

- ☒ with sufficient postage as first class mail.

**37 C.F.R. 1.10\***

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**TRANSMISSION**

- ☐ transmitted by facsimile to the Patent and Trademark Office, to **(708) 872-9306**

Date: July 16, 2004

Signature

CLIFFORD J. MASS

(type or print name of person certifying)

**\*WARNING:** Each paper or fee filed by "Express Mail" **must** have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 C.F.R. 1.10(b).  
"Since the filing of correspondence under § 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will **not** be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.

December 3, 2004, Applicant submits herewith a certified English translation of his Japanese priority application, JP 1999-375315. The Japanese application has a filing date of December 28, 1999 and Applicant thus antedates the cited European publication (EP 1010802, published June 21, 2000) for all claims that are supported by the disclosure of the priority application. The support in the priority application for the present claims is next discussed.

The compound of formula (I) defined in claim 1 of the present application is also disclosed in the priority application specifically, the compound represented by the following formula:

G1-(EP)<sub>n</sub>

wherein

G1 represents a glycerin structure;

EP represents an ethyleneoxy and/or propyleneoxy group, optionally, an OH group;

and

n represents an average of addition units, ranging from 0.5 to 10.

It is inherent that the glycerin structure is as follows:

CH<sub>2</sub>-OH

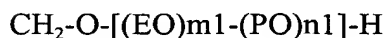
|

CH-OH

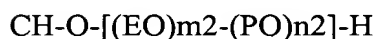
|

CH<sub>2</sub>-OH

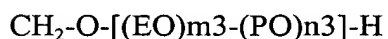
Furthermore, since EP represents an ethyleneoxy and/or propyleneoxy group, "(EP)" is (EO)<sub>m</sub>-(PO)<sub>n</sub> where EO is an ethyleneoxy group and PO is a propyleneoxy group, m and n represent the number of EO and PO. According to paragraph [0020] of the specification of the priority application, the compound represented by the formula: G1-(EP)<sub>n</sub> can be produced by reacting a glycerin with ethylene oxide and propylene oxide or reacting a glycerin with ethylene glycol and propylene glycol to perform the dehydration. In other words, as would be clear to one skilled in the art, the "(EP)" group is replaced with the hydrogen atoms of the OH groups of glycerin. As a result, the compound disclosed in the priority document is illustrated as follows:



|



|



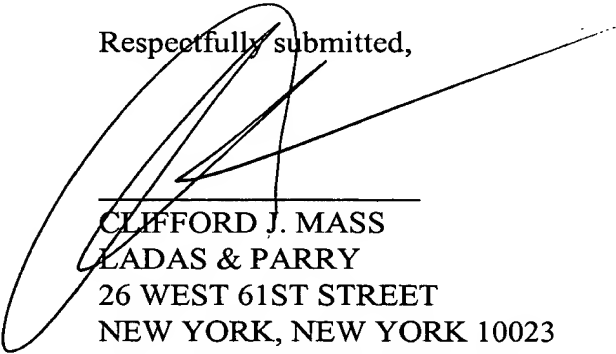
The "n" of (EP)<sub>n</sub> in the formula disclosed in the priority application obviously represents  $m1+m2+m3+n1+n2+n3$ . In addition, where n is 0.5 to 10 in priority document,  $m1+m2+m3+n1+n2+n3$  is 0.5 to 10.

Therefore, the same formula (I) of the present claims is disclosed in the specification of the priority document. Glycerin is also disclosed as a component of the ink composition, for example, in claim 3 of the priority document. Regarding claim 15 of the present application, it is also supported by claim 1 of the priority

document.

In view of the above, Applicant is entitled to the benefit of the filing date of his priority application for the claimed invention and, accordingly, antedates the cited European publication. An early and favorable reconsideration of the application is again respectfully requested.

Respectfully submitted,



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